UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,569	02/22/2000	Mizuho Tadokoro	JA9-98-196	3121

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EXAMINER
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ART UNIT	PAPER NUMBER
2143	

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DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/510,569	TADOKORO ET AL.
	Examiner	Art Unit
	Michael S. A. Delgado	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8 and 17-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8 and 17-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *22 February 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed December 27, 2002 have been fully considered but they are not persuasive. In response to argument presented which states that Rakavy does not support the step of "storing a hardware setup program and a plurality of dynamic link modules in a server data processing system". Rakavy teaches about the bootstrapping process of a remote computer being redirected to a workstation (Fig 1, 200) "server" (Col 10, lines 20-67). On this workstation (Fig 1, 200) "server" is store hardware setup program and a plurality of dynamic link modules (Col 10, lines 55-60). To provide this information from floppy or hard disk (Col 10, lines 20-30), it would have been obvious to some one of ordinary skill in the art that this information was already stored on the workstation (Fig 1, 200) prior to it being accessed.

2.   In response to the argument of "de-coupling said data processing system from said server data processing system after a completion of said hardware setup operation". Rakavy teaches about returning control to the remote computer (Col 7, lines 15-25) (Fig 4, 415). The act of returning control to remote computer (Fig 1, 400) indicates that the remote computer is able to operate on its own and is no longer dependent on workstation (Fig 1, 200) for operational code. This action is considered by any one of ordinary skill to be the decoupling of the remote computer (Fig 1, 400) from the workstation (Fig 1, 200).

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claim 1-8 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6, 324,644 by Rakavy et al.

In claim 1, Rakavy teaches about a method for performing a hardware setup operation on a data processing system, said method comprising (Fig 4):

storing a hardware setup program and a plurality of dynamic link modules in a server data processing system (Covered in response to argument);

coupling a data processing system to said server data processing system via a data processing system network(Col 9, lines 1-5);

in response to a request to execute said hardware setup program by said data processing system, executing said hardware setup program within said server data processing system (Col 4, lines 25-35);

modifying hardware configuration data within said data processing system according to instructions generated from said execution of said hardware setup program within said server data processing system (Col 4, lines 25-35); and

de-coupling said data processing system from said server data processing system
after a completion of said hardware setup operation (Covered in response to argument).

For claim 2, Rakavy teaches about a method of Claim 1, wherein when said hardware
setup operation required by said data processing system exists within an operating system
running on said data processing system, said hardware setup program performs said hardware
setup operation by using a service a provided by said operating system. (Col 11, lines 30-40).

In claim 3, Rakavy teaches about a method of Claim 1, wherein when said hardware
setup operation required by said data processing system does not exist within an operating
system running on said data processing system, said hardware setup program calls a BIOS
program within said data processing system to perform said hardware setup operation (Fig 4B).

For claim 4, Rakavy teaches about a method of Claim 1, wherein said method further
includes transferring one or more of said dynamic link modules from said server data processing
system to said data processing system via said data processing system network as a result of said
execution of said hardware setup program. (Col 10, lines 60-67).

In claim 5, Rakavy teaches about an apparatus for performing a hardware setup operation
on a data processing system, said apparatus comprising:

means for storing a hardware setup program and a plurality of dynamic link modules in a
server data processing system (Covered in response to argument);

means for coupling a data processing system to said server data processing system via a
data processing system network (Col 9, lines 1-5);

means for executing said hardware setup program within said server data processing

system, in response to a request to execute said hardware setup program by said data processing

system (Col 4, lines 25-35);

means for modifying hardware configuration data within said data processing system

according to instructions generated from said execution of said hardware setup program within

said server data processing system (Col 9, lines 25-35); and

means for de-coupling said data processing system from said server data processing

system after a completion of said hardware setup operation (Covered in response to argument).

For claim 6, Rakavy teaches about an apparatus of Claim 5, wherein when said hardware

setup operation required by said data processing system exists within an operating system

running on said data processing system, said hardware setup program performs said hardware

setup operation by using a service provided by said operating system (Col 11, lines 30-40).

In claim 7, Rakavy teaches about an apparatus of Claim 5, wherein when said hardware

setup operation required by said data processing system does not exist within an operating

system running on said data processing system, said hardware setup program calls a BIOS

program within said data processing system to perform said hardware setup operation (Fig 4B).

For claim 8, Rakavy teaches about an apparatus of Claim 5, wherein said apparatus

further includes means for transferring one or more of said dynamic link modules from said

server data processing system to said data processing system via said data processing system

network as a result of said a execution of said hardware setup program (Col 10, lines 60-67).

For claim 17, Rakavy teaches about a computer program product for performing a

hardware setup operation on a data processing system, said computer program product

comprising (Fig 4):

program code means for storing a hardware setup program and a plurality of a dynamic

link modules in a server data processing system (Covered in response to argument);

program code mean for coupling a data processing system to said server data processing

system via a data processing system network(Col 9, lines 1-5);

program code means for executing said hardware setup program within said server data

processing system, in response to a request to execute said hardware setup program by said data

processing system (Col 4, lines 25-35);

program code means for modifying hardware configuration data within said data

processing system according to instructions generated from said execution of said hardware

setup program within said server data processing system (Col 4, lines 25-35); and

program code means for de-coupling said data processing system from said server data

processing system after a completion of said hardware setup operation (Covered in response to

argument).

For claim 18, Rakavy teaches about a computer program product of Claim 17, wherein

when said hardware setup operation required by said data processing system does not exist

within an operating system running on said data processing system, said hardware setup program

calls a BIOS program within said data processing system to perform said hardware setup

operation (Col 11, lines 30-40).

In claim 19, Rakavy teaches about a computer program product of Claim 17, wherein when said hardware setup operation required by said data processing system does not exist within an operating system running on said data processing system, said hardware setup program calls a BIOS program within said data processing system to perform said hardware setup operation (Fig 4B).

In claim 20, Rakavy teaches about a computer program product of Claim 17, wherein said computer program product further includes program code means for transferring one or more of said dynamic link modules from said server data processing system to said data processing system via said data processing system network as a result of said execution of said hardware setup program (Col 10, lines 60-67).

Conclusion

3.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No 5,974,547 by Klimenko teaches about a technique for reliable network booting of an operating system to a client computer.

US Patent No 5,913,058 by Bonola teaches about a system and method for using a real mode bios interface to read physical disk sectors after the operating system has loaded and before the operating system device drivers have loaded

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael S. A. Delgado whose telephone number is 703-305-8057. The examiner can normally be reached on 8 AM - 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MD
February 20, 2003

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100